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OFFICE OF PETITIONS

In re Application of
Karsten Brauer, Frank Gansicke, Helmut
Friedrich, and Heinz Fabian
Application No. 08/897,713
Filed: July 21, 1997
Attorney Docket No.: HQ202
Title: PROCESS AND APPARATUS FOR
THE PRODUCTION OF A CYLINDRICAL
COMPONENT OF GLASS

DECISION ON PETITION

This is a decision on the petition under 37 CFR 1.137(a)¹, filed January 6, 2002², to revive the above-identified application.

On August 31, 1998, the Office mailed a non-final Office action to petitioner. On December 4, 1998, a reply was received. On March 18, 1999, a letter was mailed to the applicant, indicating that the reply was non-responsive, and giving the applicant one (1) month to reply. On April 22, 1999, an amendment was received which contained a certificate of mailing dated April 19, 1999. Again, this amendment was non-responsive, and on June 15, 1999, another letter was mailed to the applicant, indicating that this third attempt was non-responsive, and again giving the applicant one (1) month to reply. The above-identified application became abandoned for failure to reply in a timely manner to this letter of June 15, 1999. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the

1 A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

2 The petition contains a certificate of mailing dated December 31, 2002.

above-identified application became abandoned on July 16, 1999. A Notice of Abandonment was mailed on October 1, 1999.

On January 6, 2002, petitioner filed the instant petition. Petitioner has included the petition fee, a statement of facts, a copy of the record card associated with this file, and an amendment.

The instant petition lacks item (3) above.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."³

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts clearly demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked any basis in reason or common sense."⁴

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"⁵

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."⁶

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁷

3 Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency's interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

4 Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

5 Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

6 Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

7 Id.

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁸

Nonawareness of a PTO rule will not constitute unavoidable delay⁹

The burden of showing the cause of the delay is on the person seeking to revive the application¹⁰.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action¹¹.

The portion of the MPEP relevant to the abandonment of this application

MPEP 711.03(c) states, in part:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

⁸ See *In re Mattulah*, 38 App. D.C. 497 (D.C. Cir. 1912).

⁹ See *Smith v. Mossinghoff*, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing *Potter v. Dann*, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

¹⁰ *Id.*

¹¹ See *In re Sivertz*, 227 USPQ 255, 256 (Comm'r Pat. 1985).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

§ 1.121 Manner of making amendments in application.

- (c) Claims. —
- (1) Amendment by rewriting, directions to cancel or add. Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the cancellation of the previous version of that claim. A claim may also be canceled by an instruction.
 - (i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").
 - (ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.
- (2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.
- (3) A clean version of the entire set of pending claims may be submitted in a single amendment paper. Such a submission shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version is required only for claims being changed by the current amendment (see paragraph (c)(1)(ii) of this section). Any claim not accompanied by a marked up version will constitute an assertion that it has not been changed relative to the immediate prior version.

Application of the standard to the current facts and circumstances

In the instant petition, petitioner maintains that the circumstances that led to the abandonment of the application meet the aforementioned unavoidable standard and, therefore, petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner contends that this mailing was never received.

The showing in the instant petition is not sufficient to constitute unavoidable delay. The declaration of facts alleges that neither the letter mailed by the Office on June 15, 1999, nor the Notice of Abandonment was ever received. Petitioner has supplied a copy of a "manually maintained record card", where all outstanding requirements from the Office are recorded. The record card has been reviewed, and the last entry on the card is "Resp to Comm: 4-18-99 4-19-99."

Petitioner further states "Applicant's electronic records, which constitute a parallel docket system, are generally updated and no archive copy is maintained, however, a review of printed documents from around this time period did not reveal any outstanding requirement." It is noted

that no copy of this printout has been supplied, and it is further noted that the word "generally" suggests that sometimes this docket system is updated, and sometimes it is not.

Unfortunately, this evidence does not establish that the delay was unavoidable. Petitioner must submit a copy of the file jacket and the docket report where the non-received Office communication would have been entered had it been received and docketed, and establish that this docketing system is a reliable indicator of what mail has been received. A docket report is a mail log, recorded by the person who receives all incoming mail. A docket report should show all incoming mail received during the relevant time period, in order to establish that the correspondence at issue was not received, and merely misplaced and filed with another file.

Furthermore, the delay which petitioner must show to be unavoidable is the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition. Between the filing of the response on April 22, 1999, and the filing of this non-grantable petition, three years and eight months have passed. It stands to reason that a registered practitioner, acting in relation to his most important business, would have realized that something was amiss, and would not have allowed this amount of time to pass without inquiring as to the status of the application. While it is acknowledged that at times, the Office can be slow in processing applications and responding to amendments, a delay of over 3 ½ years is rather excessive.

Also, the abandonment did not stem from the PTO's failure to notify petitioner of the requirement to re-submit the amendment: the application went abandoned as a direct result of petitioner's continued failure to submit the amendment in the proper form. As a registered member of the patent bar, petitioner is expected to know the relevant laws, regulations, and fees pertaining to his practice and under which this Office operates. As stated above, nonawareness of a PTO requirement will not constitute unavoidable delay. Petitioner cannot commit repetitive errors which stem from his failure to know the manner in which amendments must be submitted, and later characterize these mistakes as unavoidable.

Should petitioner desire to file a renewed petition, petitioner should have a person with firsthand knowledge of the underlying circumstances make the necessary statement, and submit both a copy of the file jacket and a copy of the docket report. Furthermore, petitioner must address the reliability of the information contained therein, and explain this rather significant period of delay in filing this petition¹². Finally, the multiple failures to submit a responsive amendment must be addressed, and petitioner will need to show why a reasonably prudent person, acting in relation to his most important business would have continually filed amendments which did not conform to the requirements, and then wait 3 ½ years before filing this petition.

On the facts presented, this situation fails to constitute unavoidable delay. These facts might constitute an unintentional delay in prosecution, but it certainly does not rise to the level of unavoidable. Therefore, it is determined that the petitioner cannot establish that the entire delay in filing the required reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable which is required in order for relief to be granted under 37 CFR 1.137(a).

¹² Petitioner is reminded that the extreme delay in filing this petition may be considered evidence of intentional delay, which is an absolute bar to revival. As such, it would behoove petitioner to establish that this lengthy delay was unavoidable.

Consequently, the petition is **DISMISSED**.

Any request for reconsideration or petition under 37 CFR 1.137(a) must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extension of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)". This is not a final agency action within the meaning of 5 U.S.C 704.

Petitioner may wish to consider filing a petition to revive based on unintentional abandonment under 37 CFR 1.137(b)¹³. If this petition is filed, petitioner will still need to explain the delay of over three years.

Petitioner may reply to this decision via facsimile¹⁴, hand-delivery¹⁵, or by mail¹⁶.

The application file will be retained in the Office of Petitions for two (2) months.

Telephone inquiries should be directed to Paul Shanoski, Petitions Attorney, at (703) 305-0011.



Paul Shanoski
Attorney
Office of Petitions
United States Patent and Trademark Office

13 A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

14 (703) 308-6916, Attn: Office of Petitions.

15 Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

16 Commissioner for Patents, Box DAC, Washington, DC 20231.